

### **REMARKS**

This communication responds to the Final Office Action dated April 28, 2011 and the Advisory Action date July 12, 2011. Claims 1, 10, 18, and 22 are amended, no claims are canceled, and no claims are added herein. As a result, claims 1-24 are now pending in this Application. It is noted that unless otherwise stated herein, amendments to the claims have been made to clarify meaning, correct typographical errors, provide proper antecedent basis, and/or provide consistent terminology, and not for reasons related to patentability. The amendments are fully supported in the specification as originally filed, for example, at least as shown in FIG. 1. Thus, no new matter has been added.

#### **Request for Examiner's Interview**

**If the amendments and remarks herein do not result in allowance of all claims, the undersigned formally requests that, before the issuance of any further Office Action, a telephonic interview be held between the Examiner and patent attorney Mark Muller, at the Examiner's convenience. The Examiner is requested to phone Mr. Muller at (210) 308-5677 to arrange a time for conducting the interview.**

#### **The Rejection of Claims Under § 102**

Claims 1-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sacks (U.S. Publication No. 2002/0016765A1). Since a *prima facie* case of anticipation has not been properly established, this rejection is respectfully traversed.

#### **Independent claim 1:**

It is respectfully submitted that Sacks does not disclose the feature of “**a virtual shopping cart hosted by a seller web site ... the seller web site being separate from an online payment service that includes a payment processor**” for the following reasons.

Claim 1 expressly differentiates between the seller web site and the online payment service, which includes a payment processor. The Specification of the Application supports the differentiation between a seller site (provided by a merchant server 112) and an online payment

service 110 that includes the payment processor 116. (See e.g., Figure 1, and paragraphs 0018 – 0020 of the Application).

Sacks also expressly differentiates between **a seller 104** and **a payment processor 106** (a third party payment processor). (See FIG. 1 and paragraphs 0019, 0020 and 0021 of Sacks).

It is noted that Sacks refers to a shopping cart only at paragraphs 0028, 0032, 0034 and 0036, and in claims 16, 17 and 31 (as shown below with emphasis added). No other parts of Sacks refer to a shopping cart. In these portions of Sacks, it is explicitly noted that **the shopping cart is provided and managed by the payment processor 106** (rather than by a site of the seller 104). (See e.g., paragraph 0028 of Sacks). No other teaching is found in Sacks.

Moreover, as noted by the Board of Patent Appeals, Sacks shows “the “payment processing module” of the payment processor interfaces with external financial entities and is thus outside an online payment service.” See Ex parte KATHERINE WOO, Appeal 2008-2955. Therefore, Sacks does not disclose that the payment processor is included in the online payment service, as recited in claim 1.

Independent claims 10, 18 and 22:

The previous argument presented with respect to independent claim 1 also applies to independent claims 10, 18 and 22, which have features similar to independent claim 1. Sacks thus does not anticipate independent claims 10, 18 and 22 (or their dependent claims).

Withdrawal and reconsideration of the rejection of claims 1-24 under 35 U.S.C. § 102(b) is thus respectfully requested.

The Rejection of Claims Under § 103

Claims 1-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sacks in view of Ferguson et al. (U.S. Patent No. 5,966,697; hereinafter “Ferguson”). Since a *prima facie* case of obviousness has not been properly established, this rejection is respectfully traversed.

Independent claims 1, 10, 18 and 22:

As noted above, Sacks does not disclose the feature of “**a virtual shopping cart hosted by a seller web site**”, recited in independent claim 1. Nor does Ferguson. In addition, neither reference teaches that the online payment service includes a payment service, as recited in each of the independent claims. Therefore, even when combined, Sacks and Ferguson do not teach or suggest the above quoted feature as recited in independent claim 1, and thus do not render independent claim 1 obvious.

The above arguments, presented with respect to independent claim 1, also apply to independent claims 10, 18 and 22, which include features similar to independent claim 1. Accordingly, the cited references (Sacks and Ferguson) do not render independent claims 10, 18 and 22 obvious.

All dependent claims depending from independent claims 10, 18 and 22 are also nonobvious, since any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03.

It is therefore respectfully requested that the rejection of claims 1-24 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

**CONCLUSION**

The undersigned respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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